
UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

No. 16168

VAN BRODE MILLING Co., INC.,

Appellant,

—against—

COX AIR GAUGE SYSTEM, INCORPORATED,

Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
SOUTHERN DISTRICT OF CALIFORNIA, CENTRAL DIVISION.

APPELLEE'S BRIEF

BUCHALTER, NEMER, FIELDS & SAVITCH,
629 South Hill Street,
Los Angeles, California,
Attorneys for Appellee.

KANE, KESSLER & PROUJANSKY,
45 John Street,
New York, New York,
Of Counsel for Appellee.

EDWARD HALLE,
225 Broadway,
New York, New York,
Of Counsel for Appellee.

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—against—

COX AIR GAUGE SYSTEM, INCORPORATED,

Appellee.

APPELLEE'S BRIEF

This is an action brought by appellant against appellee for patent infringement of United States Letters Patent No. 2,710,660, and for unfair competition. The appellant claims that a battery hold down frame sold by appellee and supplied to it by Kravex Manufacturing Corp. of Brooklyn, infringes Claim 3 of the suit patent. The appellant also claims that the red color of the battery frame which it manufactures has attained secondary meaning in the automotive industry and that appellee engages in unfair competition, because its frame is of a similar color.

STATEMENT OF THE CASE

This matter reaches this Court as an appeal by the appellant (plaintiff below) from a judgment and decree dismissing appellant's complaint for patent infringement, and declaring not only that the appellee's (defendant below) device did not infringe appellant's patent but also that appellant's patent was invalid in its entirety. In dismissing the complaint the District Court also found that there was no unfair competition.

The Court below was correct and it is submitted that the appellant cannot prevail on this appeal because the evidence fully supports the findings, conclusion, and decision of the trial court.

The evidence shows: First, there is no infringement. The suit patent covers a battery hold down frame made of polystyrene modified by a copolymer of butadiene and styrene, with the copolymer (as loosely specified in the patent) having a "*high styrene content*". The appellee's frame is also made of polystyrene modified by a copolymer of butadiene and styrene. However, here the similarity ends. The range of styrene content in the copolymer of the appellee's frame is between 38% and 42% and cannot be construed to come within the definition of *high styrene content* which the inventor defined as a majority, or over 50% (although the suit patent gives no quantitative definition).

Secondly, on various grounds which will be discussed hereinbelow, the appellant's suit patent is actually invalid and the declaration of invalidity was proper.

Lastly, appellant's claim for secondary meaning in the trade for a "*red*" plastic battery frame is absurd. Appellant was unable to sustain this claim in the lower Court. There was no error in the dismissal of appellant's complaint.

HISTORY OF THE SUIT PATENT

The application for the suit patent was filed by Sidney Coleman on December 10, 1951, and specified a frame made of polystyrene which was modified by adding a copolymer, such as "Darex copolymer No. 3", produced by Dewey & Almy Chemical Company, and an added inorganic filler (R. p. 445).^{*} The specification gave no proportions of ingredients, no molding instructions, and no further data con-

^{*} (Printed Transcript of Record unless otherwise specified.)

cerning the manufacture of the composition of the frames. Moreover, it broadly states that any plastic material will do if it has the properties of the modified polystyrene (R. p. 446).

Original Claim 1 claimed a one piece open battery hold-down frame formed of plastic material comprising sides, ends connecting the sides, and "diagonal clamping members" at the corners of the frame, said frame having strength, toughness, and flexibility. Original Claim 2 claimed the frame described in Claim 1, "including lugs for engagement with means which force said clamping members into engagement with the battery top" (Pltf.'s Ex. 2, p. 6, R. p. 19).

The claims were rejected on September 5, 1952 on the basis of prior art patents to Mabey, Heitshn and Leuvelink (R. pp. 446, 447), and finally rejected on July 2, 1953 (R. pp. 448-450). The examiner found that the provision of diagonal clamping members in an integral frame, was found in the prior art, and did not amount to invention (R. p. 447). He also found that the selection of a specific plastic from among many compounds available on the market, in order to secure one which is judged best for particular service, is an every day practice in the field of plastics and is not considered a basis for patentability (R. p. 449).

Applicant appealed from this final rejection. The Board of Appeals of the Patent Office made its decision on March 16, 1955. The examiner's rejection of the original Claims 1 and 2 as unpatentable over the prior art was affirmed. The Board stated "Leuvelink clearly discloses the use of a hold-down device made of plastic material and there would certainly be no invention in making the hold-down clamp of Mabey out of plastic material, if desired" (R. p. 453). However, the Board said that it would not be obvious from the patent to Leuvelink "to select a plastic which would possess the required strength and toughness and still have enough flexibility to prevent breakage of the battery top when the hold-down devices were clamped in position" (R. p. 453).

The most significant portion of the Board's opinion is contained in a new ground of rejection in which they stated as follows:

"The appealed claims are also considered to be unpatentable in that they are broader than the disclosure. The specification points out that ordinary polystyrene cannot be used and it is only when a copolymer identified as '*Darex copolymer No. 3*' and an inorganic filler, such as clay, are added that a product results with the desirable characteristics. It seems clear that experimentation would be necessary in order to ascertain the desirability of using other plastic materials since the record does not disclose any other material which could be used successfully as a substitute for appellant's one example of a modified polystyrene. This being so, appellant's claims which are drawn broadly to the entire class of plastic materials are obviously broader than the disclosure." (R. p. 454) (Italics supplied.)

After the decision of the Board of Appeals, the applicant submitted amendments to the specification and claims and asked the primary examiner to reconsider the case. At this time applicant filed a Technical Bulletin of May 1949, of the Dewey & Almy Chemical Company which described "Darex Copolymer No. 3. (This technical bulletin is a part of the suit patent file wrapper, Pltff.'s Ex. 2, pp. 61-64; and was also in evidence as Deft.'s Ex. J, which is printed on pages 513-516 of the Transcript of Record.) The Dewey & Almy technical bulletin defines "Darex Copolymer No. 3 (as) an elastic type of synthetic rubber resin made by copolymerizing butadiene and styrene to produce a Buna S with a high styrene content" (R. p. 513). The specification of the suit patent was amended to contain this definition (R. pp. 456, 458).

However, although the technical bulletin shows the styrene content of Darex copolymer No. 3 as 70% (R. p. 516) neither the specification nor the claims were amended to reflect or contain this.

Original Claims 1 and 2 were cancelled. The four new claims became Claims 1, 2, 3 and 4 of the suit patent. New Claim 1 was substantially identical to original Claim 1 except that it contained the following new phrase, "the plastic material of which said frame is formed comprising polystyrene the mechanical and physical properties of which have been modified by the addition of a Buna S with a high styrene content" (R. p. 456).

New Claim 2 added an inorganic filler to the frame claimed in Claim 1 (R. p. 457).

New Claim 3, however, while defining the copolymer "with a high styrene content" *was made much broader than the original claims by leaving out the side and end structure of the frame joined by the "diagonal clamping members"* (R. p. 457). The only structure left in the claim, aside from the part loosely defining the plastic material reads as follows:

"3. A one piece battery hold-down frame formed of plastic material and including elements bearing against the sides and top of the battery, * * *"
(balance of claim defines the plastic and properties).

New Claim 4 merely redefines Claim 3 with the addition of an inorganic filler (R. p. 457).

Thus, Claim 3 which leaves out the clamping members, actually describes a frame, or cover, made of plastic material (with a copolymer of a high styrene content) which fits over the sides and top of a battery. No specific type or structure of frame is described.

It is submitted that these four claims are still far too broad and invalid since they fail to limit the composition of

the plastic material to a polystyrene modified by a copolymer of butadiene and styrene *with a styrene content of 70% and an added organic filler*. (The Board of Appeals noted that the disclosure was limited to Darex copolymer No. 3 plus an inorganic filler, since this was the only example given.)

The patent specification says the Darex No. 3 is added to improve "strength, toughness, and flexibility" (R. p. 443, Column 2, Lines 54-56) *and the organic filler, such as clay, is added to provide "sufficient elasticity to yield under pressure"* (R. p. 443, Column 2, Lines 57-61). These were the qualities desired by the "inventor".

In accordance with the decision of the Board any claim which did not contain both limitations, the copolymer with a specific styrene content of 70%, and an inorganic filler; would be broader than the disclosure. The new claims were never approved by the Board of Appeals, they were not limited to the disclosure, Claims 3 and 4 were further broadened by leaving out the diagonal clamping elements.

It is therefore submitted that on the basis of the file wrapper alone the claims are invalid.

THE ACCUSED FRAMES

Appellee's frames are supplied by the Kravex Manufacturing Corp. of Brooklyn, New York, which company hereinafter will be referred to as "Kravex". The frames are manufactured for Kravex by Gary Enterprises Inc. of Brooklyn, New York, hereinafter referred to as "Gary" (R. pp. 461, 462).

Prior to engaging in distribution of plastic battery hold-down frames, Kravex caused a search to be made in the United States Patent Office with particular reference to appellant's suit patent No. 2,710,660. As a result of this search Kravex advised Gary to avoid infringement of the patent. A discussion was had with the supplier, The Bakelite Company, and a non-infringing material was selected (R. pp. 139-141, 170-172, 511-516, 521).

The file wrapper showed that the appellant's claims covered a product modified by copolymer of butadiene and styrene with a high styrene content; the specific example given was 70%.

The choice of material (Bakelite TMD 2155) was made on the basis of avoiding infringement of the suit patent (R. p. 172). The styrene content in the copolymer of the Bakelite material is in the range of 38% to 42 % (R. pp. 461, 462), *a low styrene content*.

Furthermore, the accused frames do not have the diagonal clamping members which were considered so important to the applicant for the suit patent as to have been included in the structure of both of the original claims. These diagonal clamping members remained in the only claims under consideration by the Patent Office from the date of filing in December 1951 until April 1955, but are missing in Claim 3 upon which appellant relies.

ARGUMENT

POINT I

INFRINGEMENT

(A)

Appellants failed to sustain the burden of proving infringement in the Court below. The trial court's findings of non-infringement were correct.

This Court held in *Patterson-Ballagh Corp. v. Moss*, 201 F. 2d 403 (C. A. 9, 1953) at page 407:

"Infringement is a question of fact. See *Stilz v. United States*, 1925, 269 U. S. 144, 147, 46 S. Ct. 37, 70 L. Ed. 202; *United States v. Societe Anonyme des Anciens Etablissements Cail*, 1912, 224 U. S. 309, 322, 32 S. Ct. 479, 56 L. Ed. 778. The trial court resolved the question in favor of appellees. This determination is not clearly erroneous within the meaning of Fed. R. Civ. P. 52(a), 28 U. S. C. A."

It was readily apparent to the Trial Court that there was no infringement of the suit patent. The finding of non-infringement was a finding of fact based on the evidence. It is submitted that it was correct, and there was no error. Certainly, it was not *clearly erroneous*.

The findings were made on the following facts:

The composition of appellee's battery frame was established by stipulation as being made of a molding powder manufactured by Bakelite Company, and known as TMD 2155 (the same product was formerly put out by Bakelite as BMSQ 155 and in reference to this product the designation TMD 2155 includes the prior nomenclature) (R. pp. 461-463).

It was also established by stipulation that appellee's battery hold down frames comprised a physical mixture consisting of a predominant amount of polystyrene, a minor amount of copolymer of butadiene and styrene, and a small amount of pigment to produce the color of the frame; the mentioned copolymer consisting of butadiene in the range of 58% to 62% by weight, and styrene in the range of 38% to 42% by weight (R. pp. 461-462). Thus, the facts as to composition of the accused frames are not at issue.

Claim 3 of the suit patent on which the appellant relied contains the following limitation:

“ * * * the plastic material of which said frame is formed comprising polystyrene, the mechanical and physical properties of which have been modified by the addition of a Buna S with a high styrene content, * * *.”

Assuming, *arguendo*, that all portions of Claim 3, with the exception of the limiting phrase “Buna S with a high styrene content” read on the appellee's frames, the question of infringement turns on whether or not the accused devices do, in fact, have as a component a copolymer of a Buna S *with a high styrene content*. The Court below found in Finding of Fact No. 44 (R. p. 52) that the appellee's frames were made of polystyrene and a copolymer with a low styrene content. It follows that there is no infringement (as was found in Conclusion of Law No. 11, R. p. 56).

Appellant makes Specification of Error No. 14 to the Trial Court's Finding of Fact No. 44, with the argument that high styrene content means a content higher than 25%, the styrene content in Standard G R-S employed as a general, all-purpose substitute for rubber (Aplt.'s Br., p. 9). Appellant also makes Specification of Errors No. 27, to Conclusion of Law No. 11, that the accused frames do not infringe the suit patent (Aplt.'s Br., p. 12).

It is submitted that G R-S, which is nowhere mentioned in the specification or claims of the suit patent, is not a standard for styrene content, nor does it, in any event, relate to the term "a Buna S with a high styrene content". The Trial Court, having before it evidence of a proper range of styrene content; from below 50%—a low content, to above 50%—a high content (R. p. 287) properly found that the accused devices had a copolymer with a low styrene content.

The question of infringement hinges on the interpretation and meaning to be accorded to the claim of the suit patent, which it is submitted is most indefinite.

It is well settled that the burden of proving infringement is on the patent owner. This burden requires appellant to prove that the accused devices come within the claim of the suit patent. There is no clear antecedent in either the specification or the claims of the suit patent supplying a basis or standard for the term "high styrene content". Yet the entire question of infringement hinges upon the meaning of the term.

The appellant produced Mr. Isadore Miller as an expert witness to establish that the term "high styrene content" was well known in the art in referring to a copolymer of butadiene and styrene, to mean more than 25% styrene in the copolymer. Mr. Miller attempted to do this by establishing a standard content of 75% butadiene and 25% styrene for the copolymer. It would follow, according to his testimony, that a copolymer with a content of more than 25% styrene would be a copolymer with a "high styrene content".

Mr. Miller came to his conclusion by defining the "Buna S" of the patent claim as the general class name given to copolymers which are used as synthetic rubbers (R. p. 193). He then defined the term G R-S as the designation of "Government Rubber Styrene" (R. p. 194), which is a butadiene styrene copolymer made from approximately 75% of butadiene and 25% of styrene (R. p. 195). Mr. Miller then

arbitrarily took his G R-S (75% butadiene and 25% styrene) as the standard form of copolymer of butadiene and styrene and flatly stated that any Buna S with styrene content over 25% was a high styrene content copolymer (R. pp. 195-211).

On the other hand, the appellee's expert, Prof. R. B. Stringfield, testified that the range of butadiene and styrene in the copolymers under discussion varied from a high butadiene *low styrene* content (99% butadiene-1% styrene) to a low butadiene *high styrene* content (1% butadiene-99% styrene) (R. pp. 284, 285). He testified further that the range below 50% styrene would be a *low styrene content* copolymer, and that the range above 50% styrene would be a *high styrene content* copolymer (R. p. 287).

On cross-examination, the appellant's expert, Mr. Miller admitted that he knew of a Buna S with a high styrene content—as high as 85% (R. p. 219). He also defined Dewey & Almy Darex No. 3, a copolymer with styrene content of 70%, as another high styrene Buna S (R. p. 219) (Darex No. 3 is the only example mentioned in the suit patent). Although he asserted that the terms G R-S and Buna S are used interchangeably (R. p. 223), he later conceded that he knew of no G R-S with a styrene content higher than 50% (R. p. 240).

On direct examination, Mr. Miller quoted from several publications concerning G R-S rubbers, to show that his G R-S rubber was a standard for the entire range of styrene butadiene copolymers (which are loosely defined as a Buna S in the suit patent and not as G R-S rubbers).

However, he could not point to any publication which gave a standard G R-S as a standard for all high or low styrene copolymers, and it became apparent that he was voicing his own personal opinion rather than a proper evaluation of what was understood by men skilled in the art. Counsel had asked him on cross-examination whether there

was a publication promulgating such a standard, and the following ensued:

"Q. Well, now, I wanted to know if you knew of a publication that set that forth in just that way, that the standard for GR-S sets the standard for what is high styrene and low styrene copolymers. A. I cannot give you any publication.

Q. There is no such publication that you know of, is there? A. I cannot give you any such publication.

The Court: So your statement is based upon your own opinion of the known practices in the industry, is that correct?

The Witness: That is correct, your Honor."
(R. pp. 242, 243).

Mr. Miller's entire hypothesis was invalid because, as he stated it was based on his own opinion, and further cross-examination revealed that his opinion did not jibe with the published literature; *which he nevertheless agreed with.*

He was shown an article entitled "Impact Resistant Resin-Rubber Blends" by H. Sell and R. J. McCutcheon of the Chemical Products Division, Goodyear Tire and Rubber Co., which was published in the October 1948 issue of the *India Rubber World*, a trade journal (R. pp. 243, 244; Deft.'s Ex. L). *India Rubber World* is a standard publication of the rubber industry (R. p. 243). The article stated in substance that since 1946 "high styrene copolymer resins" ranging from 70% to under 95% styrene were used as reinforcing and hardening agents for stocks of natural rubber, G R-S, and other synthetic materials, and had gained wide acceptance. Mr. Miller admitted the correctness of the statements in this 1948 publication and conceded that the range of 70% to 95% styrene was much higher than the range of styrene content in G R-S (R. p. 244).

A copy of Whitby, *Synthetic Rubber*, published by John Wiley & Sons, Inc., New York, in 1954, was also shown to Mr. Miller during his cross-examination, and he agreed that it was a standard work (R. p. 227). This volume at pages 629 and 630 under the subheading "High Styrene Resins" mentions that the first description of a commercially available styrene butadiene resin, Pliolite S-3, was published in 1946, and that descriptions of other "high styrene resins" were subsequently made thereafter. Mr. Miller agreed that Pliolite S-3 had an 85% styrene content, and that it was the first such product to become commercially available, and that it became available in the year 1946 (R. pp. 227, 228). He said that Pliolite S-3 was a Buna S with a high styrene content and was an equivalent of Darex No. 3 (R. pp. 229).

Whitby also showed, and this was agreed to by Mr. Miller, a listing of high styrene copolymers on page 644 entitled "Table 11, High Styrene Resins". There are some ten or fifteen resins listed on the mentioned page ranging from the lowest styrene content of 60% to the highest styrene content of 85%. Mr. Miller found Darex No. 3 (styrene content 70%) listed on the table of this 1954 publication along with Darex X-34 (styrene content 85%) (R. pp. 244-246). He admitted that Bakelite TMD 2155 (styrene content 38% to 42%) was on the market in 1954 and had been on the market since 1952, but that *it was not* listed with the "high styrene resins" shown on the table at page 644 of Whitby (R. pp. 245, 246).

Mr. Miller stated that 75-25 percent is a standard for all-purpose rubber in the rubber industry, but admitted there is *no standard in the plastic industry* (R. p. 226).*

*(By Mr. Halle):

Q. There is no standard in the plastics industry, is there? A. There is no standard for rubber, because rubber does not exist except as an aid to the plastics industry. But rubber is not in the plastics industry.

A further discrepancy in Mr. Miller's testimony was his insistence that the use of the terms G R-S and Buna S were synonymous (R. p. 223), yet he was just as definite that he knew of no G R-S of over 50% styrene, and that there are Buna S's in existence having well over 50% styrene (R. pp. 249, 250).

On the basis of this contradictory and confusing testimony from appellant's expert. It is no wonder that the Court chose the definition for high styrene content, stated by Mr. Stringfield (which the appellant's "inventor" agreed with) as meaning something over 50%.*

In all 79 pages of appellant's brief, there is no argument to discredit Mr. Stringfield's testimony (with the possible exception that he was disputed by Mr. Miller). Mr. Stringfield pointed out that it was most unrealistic to pick G R-S as a standard for the entire range of butadiene styrene copolymers. G R-S is nothing but a general purpose synthetic rubber and does not bear any particular significance to the uses for which the high styrene copolymers were introduced (R. pp. 312, 313).

Q. I see. When we are using polystyrene modified by a co-polymer of a Buna S are we in the plastics industry or are we in the rubber industry? A. We are in the plastics industry.

Q. What is the standard in the plastics industry? A. We have no standard (R. p. 226).

*Q. Professor, would you state the range of styrene content in a high styrene butadiene-styrene copolymer? A. I would consider that from 50 per cent up would be a high styrene butadiene copolymer, and from 50 per cent down would be a rubbery styrene copolymer, because of the fact that while there is no sharp break-off point there, the materials in the 40 to 50 percent range have been used as rubbers, and I do not know of any such use in the ranges above that.

Q. Would you classify the range below 50 percent as a low styrene content copolymer? A. Yes, sir, I think that would be correct.

Q. And above 50 percent as a high styrene content? A. Yes, sir, I think that would be correct (R. p. 287).

It is submitted that the above analysis of the testimony of the experts and some of the documentary evidence, clearly shows that there was more than sufficient evidence in the Record for the Trial Court to find (without clear error) that high styrene content, which was never defined in the suit patent specification and claims, could only mean higher than 50% and that, therefore, there was no infringement. It is further submitted that there was no evidence entitled to weight upon which the Trial Court could have come to any other conclusion.

Rule 52(a) of the Federal Rules of Civil Procedure, entitled "Findings By The Court," reads in pertinent part:

"* * * Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses * * *."

The factual finding that the accused devices do not infringe Claim 3 of the suit patent as construed by the Trial Court, should not be disturbed by this Court unless clearly erroneous. (*Moon v. Cabot Shops, Inc.*, 123 U. S. P. Q., 60, 64 [C. A. 9, 1959], citing *Graver Mfg. Co. v. Linde Co.*, 339 U. S. 605, 610, 70 S. Ct. 854, 94 L. Ed. 1097; *Patterson-Ballagh Corp. v. Moss, supra.*) There was no error.

(B)

The testimony of Coleman as to high styrene content.

The inventor, Coleman, testified that the term "high styrene content" meant more than 50% styrene. He gave the following answers to the following questions when his deposition was taken by appellee on January 31, 1958:

"Q. Mr. Coleman, do you know what the term high-styrene content means in reference to a butadiene-

styrene copolymer? A. I believe I do. It means that there is lots of styrene in the majority of the material—the majority of the material contains styrene.

Q. When you say majority, would you mean more than 50%? A. This would be what I think is so.

Q. In other words— A. I have nothing to substantiate. This is just my pure thinking on the thing.

Q. In other words your pure thinking on the thing, is that right? A. Yes.

Q. Indicated that a high-styrene content— A. Means more than 50%.

Q. More than 50% styrene? A. Right.” (R. pp. 381, 382).

Appellant makes a point in its brief at pages 61 and 62, that the patent owner is not bound by the inventor's statement and cites several cases. None of the cases cited by the appellant is in point.

It is well settled, as the Trial Court states (R. p. 21), and as appellant's cases hold, that an inventor need not understand the nature of the physical or chemical change involved in his process nor need he know the scientific theory involved. In the case at bar, Coleman was not called upon to explain what happened in the manufacture of his frame—he was merely called upon to explain what the main element of definition in all his claims meant. This is not a process nor a scientific theory; it is a plain statement of fact or definition in a patent claim which by law must be so clear and concise in claiming the invention that anyone skilled in the art can readily understand what it means (*Halliburton Co. v. Walker*, 329 U. S. 1, 13, 91 L. Ed. 3, 11). Thus, when the inventor says that he believes high styrene content to mean over 50%, this is a fact in evidence upon which the Court can make its fact findings as to infringement.

In *Helene Curtis Industries v. Sales Affiliates*, 233 F. 2d 148 (C. A. 2, 1956), Judge Hincks stated at page 160:

“We think the *facts* that the applicant himself and the defendant’s expert witness were in disagreement as to the meaning of the limits of the claims as stated, and *that there were several commercial compositions falling within the peripheral area of uncertainty, were significant.*” (Italics supplied.)

The same was true in the case at bar!

(C)

The appellant cannot broaden its claim 3 by the doctrine of equivalents.

Appellant argues, at pp. 67 through 69 of its brief, that it is entitled to the benefit of a “doctrine of equivalents”, and states specifically at page 68:

“It is quite clear that the term Buna S having a high styrene content is intended in the claim and specification of the suit patent to refer to a copolymer that will accomplish certain purposes in modifying polystyrene and serves to distinguish such copolymers from those that will not.”

The appellant’s statement is somewhat confusing. The claim of the suit patent is so broad that it is not necessary to rely on a doctrine of equivalents to cover a substance or composition which comes within the claimed definition of a copolymer “with a high styrene content”. If it is such a substance “with a high styrene content”, then of course it comes within the claim. However, if it is a substance with a *low* styrene content, then it most certainly does not come within the claim.

What the appellant is asking this Court to believe is that polystyrene modified with a copolymer of butadiene and styrene with a low styrene content is the equivalent of polystyrene modified by a copolymer of butadiene and styrene with a high styrene content. This, of course, is absurd.

In construing the claims of the suit patent, the common English words "low" and "high" cannot be equivalents. Nothing could be more different and opposite from "high" than "low", or vice versa. It is wishful thinking on appellant's part to believe that any plastic composition made of polystyrene modified by a copolymer of butadiene and styrene which has the functional qualities expressed as desirable in the suit patent comes within Claim 3.

Furthermore, the appellant is prevented from claiming "equivalents" through the operation of the rule of "file wrapper estoppel". The limitation "high styrene content" was placed in the claims to obviate a rejection for broadness by the Board of Appeals. The appellant cannot now seek to broaden the meaning of this express limitation to include a plastic material which does not come within the definition "high styrene content". "File wrapper estoppel" bars recourse to the doctrine of equivalents in cases where the patentee attempts to secure through equivalents what has been rejected by the Patent Office. It prevents application of the doctrine of equivalents to recapture coverage which the patentee has surrendered by amendment whether or not the prior art required the amendment, (*Carter Products, Inc. v. Colgate-Palmolive Co.*, 164 F. Supp. 503, 518, [D. C. Maryland, 1958]).

In the leading case of *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126, 136-137, 62 S. Ct. 513, 518, 86 L. Ed. 736 (1942), Chief Justice Stone of the Supreme Court stated in referring to an amendment designed to narrow a claim in order to meet objections in the Patent Office as to broadness, "By the amendment, he recognized and empha-

sized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference”.

Thus, a patentee who, in order to avoid a rejection of his application, inserts limitations in his claim is estopped from contending that the patent as issued should be construed as if such limitations had not been made, (*Westinghouse Electric & Mfg. Co. v. Conduit Electrical Mfg. Co.*, 194 F. 427, 430, [C. A. 2, 1911], cited with approval by this Court in *Bergman v. Aluminum Lock Shingle Corp. of America*, 251 F. 2d 801, 804, [C. A. 9, 1957]).

POINT II

VALIDITY

(A)

Presumptions and burden of proof.

The Trial Court found all the claims of appellant's patent invalid. This Court has consistently held that the question of validity of a claim of a patent is one of fact, (*Stauffer v. Slenderella Systems of California, Inc.*, 254 F. 2d 127, [C. A. 9, 1957] and cases cited in the margin under footnote 1). In the *Stauffer* case, *supra*, this Court stated very clearly, “The findings of a judge upon novelty, utility and invention are entitled to great weight when made after trial of these issues. This Court will respect such findings unless the record shows these to be “clearly erroneous”.

The appellant relies heavily on the presumption of validity which attaches to an issued patent, and asserts that this presumption is strengthened by lengthy consideration in the Patent Office, and the review by the Board of Appeals.

It is submitted that the evidence was so clear and overwhelmingly in favor of invalidity that the appellee's burden of proof was clearly established and the Trial Court's

findings of invalidity were not clearly erroneous but, rather, patently correct. It is submitted that reliance on presumptions and rules of law, as cited in appellant's brief, are ineffectual to disturb what the evidence established. There was never any reasonable doubt concerning the validity of the suit patent which could have been resolved in appellant's favor.

Let us analyze the meaning of the presumption. This Court has held that the presumption of validity necessarily arises from the expertness of the administrative agency issuing the patent (*Massa v. Jiffy Products Co., Inc.*, 240 F. 2d 702, 706 [C. A. 9, 1957]; *Patterson-Ballagh Corp. v. Moss*, *supra*, at p. 406). The file wrapper history of the suit patent shows that the primary examiner approved the claims without adequate regard for the meaning and mandate of the decision of the Board of Appeals, and without making a further search in the plastic arts. Thus, the Patent Examiner permitted the patent to issue with broad claims which did not specify the particular plastic material disclosed in the specification. It is submitted that for this reason alone, the presumption of validity must fall.

A long history of trouble and controversy in the Patent Office does not necessarily always result in a strengthening of the presumption of validity. The fact that many years are required to persuade the Patent Office to allow the claims indicate more often, than not, doubt as to validity and clearly weaken the presumption (*Hoover Co. v. Mitchell Mfg. Co.*, 122 U. S. P. Q. 314, 317, [C. A. 7, 1959]). Although appellant emphasizes in its brief (p. 45) that the application included a review by the Board of Appeals, it is clear that the Board of Appeals did not pass on the final claims and appellant cannot, therefore, rely on this factor in connection with presumption of validity.

(B)

The History of the Alleged Invention.

High impact plastics were first introduced commercially in 1946, and the concept of modifying brittle polystyrene with a copolymer of butadiene and styrene to produce a molded product having great strength was established long before Coleman. This is readily conceded by appellant. It is stated on page 21 of appellant's brief, as follows:

"It is to be emphasized that Coleman does not claim to have originated either battery hold-down frames or a new plastic. What he did invent and does claim is a plastic battery hold-down frame made of a particular type of plastic material suitable for his purposes."

The December 1948 issue of *Modern Plastics* magazine contains an article on "Molding High Styrene Resins" on page 190 (R. p. 293; Deft.'s Ex. M). The article quoted from a letter received from the Dewey & Almy Chemical Company and signed by K. M. Fox, Organic Chemicals Division. Mr. Fox's letter, which was published in the magazine, stated that Dewey & Almy used Darex copolymer X-34 (styrene content 85%) as an extender and plasticizer for polystyrene in order to make the latter material useful in applications where ordinarily it would be too brittle, and that the X-34 greatly improved the impact strength (R. p. 294). The Dewey & Almy technical bulletin on Darex copolymer No. 3 (R. pp. 513-516) was published in May, 1949, and appellant concedes in the suit patent file wrapper that it received "wide distribution throughout the United States, thereby forming part of the published literature on the subject * * *" (R. p. 458). This bulletin explained the properties of Darex copolymer No. 3, its styrene content, and also listed "commercial application and suggested uses" which included "automotive molded parts,

battery boxes, electrical molded parts, and plastic molded parts" (R. p. 516).

The 1950 edition of *Modern Plastics Encyclopedia Handbook*, which was published on or about June, 1950, contained an article entitled, "Styrene Polymers and Copolymers" (R. p. 288; Deft.'s Ex. T). Page 754 of the mentioned publication announced that a new styrene-base copolymer was announced during 1949 which offered impact strength plus excellent stability, and particularly noted its resistance to *battery acids* and gasolines. The article stated that initial applications of the material included *battery cases* and parts as well as housings for business machines. The same article also stated that a high styrene butadiene copolymer has been blended with polystyrene to give tough, fairly transparent blends. The copolymers mentioned in the article were Darex copolymer No. 3 (70% styrene) and Darex copolymer X-34 (85% styrene) (R. p. 289). This publication is a standard reference work in the plastics industry (R. p. 289).

Augustine L. Colarusso, the Vice-President in charge of research and development of the appellant (R. p. 341), testified that new developments in plastic powders are usually submitted to his company for evaluation and possible application to the company's products (R. p. 351). Prior to October 15, 1951 the appellant received samples of various copolymers of the Dewey & Almy Company together with technical bulletins for Darex No. 3 and Darex copolymer X-34, as well as Darex copolymer X-43 (R. pp. 354, 355). It was during the year 1951 that Sidney Coleman claims to have conceived the alleged invention of the suit patent. Appellant concedes that Coleman neither invented the frame nor the plastic material. What then did he invent? Nothing. He never even learned how to mix polystyrene with Darex copolymer No. 3 to produce a consistently successful battery frame (R. pp. 348, 357, 379).

It is submitted that the plastic battery hold-down frame is a natural development in the art and did not amount to invention. Mr. Colarusso admits having conversations with Karl Fox of the Dewey & Almy Company (R. p. 345) during the year 1951. The published literature shows as early as 1948 that Karl Fox was preaching the modification of polystyrene with high styrene copolymers such as Darex X-34 and Darex copolymer No. 3.

Mr. Coleman's frame was not the result of his "inventive genius" (or even lack of it), but was based on the Dewey & Almy bulletins, the publications in the art, and the solid "know-how" of Karl Fox of Dewey & Almy, as related to Mr. Colarusso. The proof of the pudding is that while Dewey & Almy were successful in making a molding powder with polystyrene and the high styrene copolymer, Coleman never was.

Sometime in 1952, the appellant was solicited by the Bakelite Co., either through its representaives, or by means of technical data furnished to the trade, to try a product known as BMSQ-155 (R. pp. 342, 343, 351, 463). BMSQ-155 was introduced by the Bakelite Co. in 1951 and the same product was later redesignated by them as TDM-2155 (R. pp. 359, 463). The product will be referred to simply as the Bakelite Product.

The Bakelite Product is a complete molding material in form of pellets and comprises a majority of polystyrene and a minor amount of a copolymer of butadiene and styrene. The styrene content in the copolymer is in the range of 38% to 42% by weight. This is a *low* styrene content.

After the Bakelite Product was called to the attention of the appellant, it ceased using the mixture comprising Darex Copolymer No. 3. This was in 1952 within a few months *after* the application for the suit patent was filed. The use of the Bakelite material gave the appellant its first commercially acceptable product.

It required only ordinary skill in the field of plastics to select the material for the appellant's frame from plastic materials within the common knowledge of the art.

Steel battery hold-down frames were well known long prior to the alleged invention herein. All Coleman did was to substitute a plastic material *well known in the art* for the results desired. This was a natural development in the plastics industry and followed the introductions of Darex Copolymer No. 3, in 1949, and the Bakelite material, in 1951.

There was a revolution in the industry. It was possible to make many common articles out of high impact plastic which were formerly made of metal or wood only. Examples are radio and television cabinets, toy trains, parts for machinery, plumbing pipes, gears, battery hold-down frames and a host of other products. The credit for the development of new plastic materials of great strength goes to the suppliers of the molding powders, not to Coleman.

(C)

Coleman's substitution of material did not amount to invention.

It would serve no useful purpose to further emphasize that the substitution of plastic for steel in a battery hold-down frame was merely a result of the general industrial revolution in which many metal products in all phases of industry were replaced and supplanted by plastic products. Thus, the substitution of a plastic for metal is to be expected and does not amount to invention. This concept is not incompatible with the cases cited by appellant.

(D)

The suit patent is invalid for inadequate disclosure because it fails to state both the proper proportions of polystyrene to copolymer and the proper range of styrene content in the copolymer.

No formulae, or specific examples, showing the proportions of the ingredients are anywhere stated in the specification or claims of the suit patent. The patent therefore fails to teach one skilled in the art how to produce the invention. In addition, the specification and claims are completely silent as to the molding process, molding temperatures, pressure and other relevant data necessary to produce a commercially acceptable product. The claims are not supported by an adequate disclosure.

There are many combinations of polystyrene and a copolymer of butadiene and styrene which would be inoperative. Mr. Coleman testified that appellant's original production was in the ranges of 88% to 80% polystyrene and 12% to 20% of the copolymer (R. p. 371). However, this information is not available anywhere in the patent or its claims.

It is also true that the styrene content in the copolymer is critical. The use of the term *high styrene content* is therefore much too broad. The specification does not fulfill the minimum standards of the Patent Laws as to sufficiency of disclosure and the patent is invalid. Full disclosure is basic to the underlying principles of patent law to make sure that the invention will ultimately be dedicated to the public (*General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 364, 369, 82 L. Ed. 1402, 1405 [1938]); and also to guard against unreasonable advantages to patentee and disadvantages to others arising from uncertainty of their rights (*Zoomar, Inc. v. Paillard Products, Inc.*, 152 F. Supp. 328, 338, footnote 14, [D. C. S. D. New York,

1957]). A patentee cannot obtain greater coverage by failing to describe his invention than by describing it as the law commands (*Halliburton Co. v. Walker, supra*).

The inadequacy of disclosure in the suit patent was deliberate. During the pre-trial depositions the appellant's witnesses and its counsel refused to reveal the proportions used by the appellant in its frames marked with the number of the suit patent, even going so far as to claim a "trade secret" (R. pp. 371, 372). This is certainly incompatible with the legal requirement for full disclosure.

Furthermore, Claim No. 3 of the suit patent, defines the appellant's frame as polystyrene modified by a Buna S with a *high styrene content*, and then qualifies this entirely too broad definition by setting forth the desired qualities such as improved heat resistance, strength, toughness and flexibility. A claim cannot be valid which uses functional language in place of specific proportions at the very point of alleged novelty (*Georgia-Pacific Plywood Co. v. U. S. Plywood Corp.*, 148 F. Supp. 846, 866, 867, [D. C. S. D. New York, 1956]). An invention must be capable of accurate definition, and it must be accurately defined, to be patentable (*United Carbon Co. v. Binney Co.*, 317 U. S. 228, 237, 63 S. Ct. 165, 87 L. Ed. 232, 238, [1942]). The requirement of the Patent Act for definiteness in the statement of the claims must be strictly construed (*Helene Curtis Industries v. Sales Affiliates, supra*, at page 160).

(E)

The suit patent is invalid because the one example given lacked utility.

The evidence concerning lack of utility of the frames made with Darex Copolymer No. 3 has been discussed above. Coleman himself stated that the frames made out of the Darex were not a commercially acceptable product because

they had breakage. He said that they shipped frames out and they came back broken, and "that's when we started to look for trouble" (R. p. 379). Coleman definitely stated that the Darex material was not satisfactory for commercial production because of the uncertainty of the mix (R. p. 379). When he was asked whether he had any records concerning the history of the changeover from Darex to the Bakelite product, he answered:

"No. It was done so quickly after the discovery that we were having mixing problems, that there was nothing except my complaint, *which you could have heard all over the place.*" (R. p. 379; Italics supplied.)

Thus, there was sufficient evidence for the Trial Court to make a fact finding of lack of utility and this was not clearly erroneous. The appellant recognizes the weakness of its argument and tries to state that even if only partial success is obtained, this is sufficient proof of utility.

It is submitted that there is a fallacy in the appellant's argument since the cases cited refer to products which were intrinsically useful, but which perhaps did not operate in all possible applications. For example: *Freedman v. Overseas Scientific Corporation*, 248 F. 2d 274 (C. A. 2, 1957), upon which the appellant relies at page 52 of its brief, concerns an invention for dentures. The evidence in that case showed that the dentures were not useful in certain patients with certain types of mouth structure. That was not a case where the producer could not make a commercially acceptable denture, it was rather a case where the denture did not have universal application.

(F)

There is no evidence of commercial success of the product claimed in the suit patent.

We are in agreement with appellant in its statement on page 47 of its brief that “* * * commercial success alone will not supply the element of invention where it is otherwise lacking * * *.” In this instance, appellant produced evidence of sales of its plastic battery frames (R. p. 460). Reference to this evidence shows that approximately \$16,000.00 worth of frames was sold between June of 1951 and June of 1952 (about 1% of the total sales claimed for a six-year period). This was when appellant was experiencing its difficulties with Darex Copolymer No. 3. In or about June, 1952, appellant switched over to the Bakelite product and never again used the Darex as specified in the patent. Thus, none of the frames sold after June, 1952 was made in accordance with the patent specification or claims.

It is clear that 99% of appellant's sales is therefore attributable to the product of a later period which does not come within the patent.

Most significant is the fact that automobile manufacturers do not use plastic battery hold-on frames as original equipment in cars, *but still prefer to use steel* (R. pp. 88, 336, 337).

It is also significant that in order to sell its frames, appellant expends approximately 10% of its sales in advertising and sales promotion, and that the cost of the sales promotion of the battery frames upon which the commercial success was claimed amounted to approximately \$150,000.00 (R. pp. 266, 267).

It is therefore clear that the commercial success which appellant claims is attributable to frames made of a copolymer with a low styrene content, such as the Bakelite material, and not to frames made with a copolymer of a high styrene content, as disclosed and claimed in the patent.

(G)

There was no evidence of a long felt need.

In view of the fact that all automobile manufacturers still use steel battery hold down frames as original equipment (R. pp. 88, 336, 337), it would seem that the Coleman "invention" did not actually fill a long felt need. High impact plastics were developed and introduced generally to the public at or about the time that Coleman attempted to make his plastic battery frame. Thus, if there indeed was a real need for a plastic frame, then neither Coleman, nor anyone else, could have filled this so-called "need" prior to the advent of the proper material. It is absurd for appellant to state that Coleman filled a long felt need with his frame only after he could obtain the proper plastic material for it and that, therefore, he is undoubtedly an inventor.

Appellant cites the "weeping doll" case, *Brown v. Brock*, 240 F. 2d 723 (C. A. 4, 1957), to show that filling a long felt, unsatisfied want is proof of invention. In that case the Court stated:

"Long before the patent in suit, toy manufacturers had attempted repeatedly without success to produce a satisfactory realistic weeping doll." (p. 735.)

* * *

"The record shows a long felt and unsatisfied want for an acceptable weeping doll. As we have seen, a number of devices were attempted, but none served the purpose." (p. 727.)

In the case at bar, however, there was no evidence of such a long felt, unsatisfied want nor of repeated unsuccessful attempts to make a plastic battery frame out of a true high impact plastic.

(H)

The Ditz patent was properly admitted under Title 35 U. S. C. Sec. 102(e).

The Court made Findings of Fact numbered 29 and 30 (R. pp. 48, 49) concerning the Ditz patent (Deft.'s Ex. A). Finding of Fact 29 notes the production in evidence of the Ditz patent dated December, 1951, and that it was not cited by the Patent Office during the prosecution. Finding of Fact numbered 30 gives the filing date of the Ditz patent as May 26, 1948, and states that it actually gives the preparation for a composition plastic material for battery containers which shows the greatest durability. Also, that Claim 5 of the Ditz patent covers a plastic battery container of polystyrene modified by a copolymer of butadiene and styrene with the styrene content in the copolymer ranging from 20 to 50 per cent by weight.

The appellant did not specify as error the making of Findings of Fact numbered 29 and 30. However, the appellant did assign as error the fact that the Court admitted the Ditz patent in evidence as Defendant's Exhibit "A". (See appellant's brief, pp. 12 and 13).

Appellant states at page 56 of its brief:

"The patent to Ditz, *et al.* was offered and *accepted in evidence as prior art* despite the fact that it issued subsequently to the filing date of the suit patent."
(Italics supplied.)

The statement is incorrect because while the Ditz patent was originally offered broadly, it appears that during the colloquy counsel for appellee conceded that it was not a prior publication and also agreed with the Court that it would be introduced in a limited scope as evidence as an anticipation, under Section 102(e) of Title 35 U.S.C. Neither the Court's Opinion nor the Findings of Fact, nor

the Conclusions of Law, indicate that the Court treated the Ditz patent in any way other than as evidence of anticipation, in accordance with the appellant's interpretation of the rule of *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U. S. 390, 46 S. Ct. 324, 70 L. Ed. 651 (1926) as codified in Section 102(e) of Title 35 of U.S.C. (See appellant's brief, pp. 56 to 61.)

Section 102(e) of Title 35, states in pertinent part as follows:

"A person shall be entitled to a patent unless——

* * *

(e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent * * *."

Reference to page 296 of the Record shows the following colloquy on the objection to the Ditz patent:

"Mr. Halle: I will concede that it is not a publication prior to the filing date.

The Court: All right. Let it be received. The scope may be limited. I haven't the time to stop now and look at your interrogatories. Concededly it is introduced to show what—the status of the art?

Mr. Halle: As an anticipation under the well settled law——

The Court: Under that subdivision described in the patent?

Mr. Halle: That is right, 102(e), I believe.

Mr. Caughey: 102(e).

The Court: All right. It may be received."

Thus, the Court received the Ditz patent only on the question of anticipation. The Trial Court had ample evidence before it to decide that the disclosure of the Ditz patent anticipated the suit patent.

The Ditz patent disclosed and claimed a battery container made of polystyrene modified by a copolymer of butadiene and styrene. It mentioned battery covers. Claim 3 of the suit patent defines a battery hold down frame with no specific structure other than elements to bear on the top and sides of a battery. This is what a cover does too. Suit patent frame is also made of styrene modified by a copolymer of butadiene and styrene.

The Ditz patent was filed on May 26, 1948. This was prior to the December issue of *Modern Plastics* (Deft.'s Ex. M). It was a pioneer patent, early in the art of high impact plastics and entitled to a broad range of equivalents. It was certainly broad enough to cover the type of plastic hold down frame of Claim 3 of the suit patent.

However, it is submitted that the appellant misinterprets the rule of law. The rule of law of the *Milburn* case rested on the theory that a patent application is a "reduction to practice" for everything that is disclosed in that patent application, whether claimed or not. The following significant language is contained at pages 401, 402, of the Supreme Court's Opinion:

"It is said that without a claim the thing described is not reduced to practice. But this seems to us to rest on a false theory helped out by the fiction that by a claim it is reduced to practice. A new application and a claim may be based on the original description within two years, and the original priority established notwithstanding intervening claims. *Chapman v. Wintroath*, 252 U. S. 126, 137, 64 L. Ed. 491, 495, 40 Sup. Ct. Rep. 234. A description that would bar a patent if printed in a periodical or in an issued patent is equally effective in an application so far as reduction to practice goes."

Thus, even though a patent such as the Ditz patent (which issued one day after the suit patent's filing date), is not a prior publication, it is nevertheless the equivalent of a prior publication for all probative purposes in accordance with the direct language quoted from the *Milburn* case, *supra*. Even if the Trial Court had considered and had given the Ditz patent the same weight as prior art and prior publication, this would not have been an error.

On the other hand, it is clear that the Court accepted the evidence for the limited scope of anticipation only. Conceding, *arguendo*, that the Ditz patent is not an anticipation, and had been considered in finding invalidity, it would have been harmless error, since, Conclusion of Law No. 9 held that, "The subject matter of the (suit patent) was stated in more than one printed publication in evidence published more than one year prior to the date of application for the patent, and in accordance with Title 35, U. S. C. Sec. 102, the patent is invalid in its entirety." (R. p. 56.)

The finding of invalidity did not therefore rest solely on the Ditz patent, but on at least one prior publication of which there were many in evidence.

(I)

The publications used as prior art teach how to practice the invention as clearly, if not more clearly, than the specifications and claims of the suit patent.

It has been submitted hereinabove that the suit patent is invalid and was rightly held to be invalid because of inadequate disclosure. No proportions are given, no method of manufacture is given. The only technical information which is given refers to a product called "Darex No. 3", and it is a technical bulletin of the Dewey & Almy Co. which was filed with the suit patent wrapper which gives all of the information concerning this product. This tech-

nical bulletin was published more than one year prior to the patent application. Thus, the Dewey & Almy Exhibit, alone, teaches how to produce the invention as clearly as does the patent. However, we need not rely on this one publication. The other publications in evidence teach that polystyrene can be modified by copolymer with high styrene content to produce a molded article such as a battery frame having the qualities desired and listed in appellant's suit patent, and this is all that the suit patent discloses (R. pp. 288-294).

Thus, the prior publications disclose as much as the suit patent does. Therefore, if the patent is adequate and clear, so are the prior publications.

POINT III

FACTS AND LAW CONCERNING THE ALLEGED UNFAIR COMPETITION.

The appellant seeks to claim exclusive right to the color *red* for its frame. All features of the frame, including the color, are functional and cannot be the subject of a claim of unfair competition. There is no design feature involved in the use of a single functional color for the entire article. In view of the fact that many items in the automotive trade are similarly colored red, it is inconceivable that appellant's battery frame could achieve any significance in the minds of the public from the color frame. Even if the color was not functional, it cannot be the subject of exclusive appropriation by appellant.

What appellant is really asking for is the right to the exclusive use of the color red. If it monopolizes red and the next manufacturer monopolizes orange and the next, yellow, etc., obviously the list of colors would soon run out. The appellant cannot have an exclusive use of the color red. (*Campbell Soup Company v. Armour & Co.*, 175 Fed. 2d 795, 798 [C. A. 3, 1949].)

In any event, the appellee's frames are certainly packaged to distinguish the source of merchandise, and no consumer confusion is likely. (*Kellogg Co. v. National Biscuit Company*, 305 U. S. 111, 120, 83 L. Ed. 73, 79 [1938]; *Sylvania Electric Products, Inc. v. Dura Electric Lamp Co., Inc.*, 247 F. 2d 730, 733, 734 [C. A. 3, 1957].) The plastic battery frames at issue are usually attached as replacements for worn-out battery frames under the hood of automobiles, and the customers rarely see them (R. p. 387). The need for a new frame is usually called to the attention of the customer by a service station attendant when a new battery is installed. Mr. Coleman, the appellant's Director of Sales, affirms that the consumer never knows what he is getting (R. p. 388). In a similar situation involving the sales of automobile replacement parts, it was held that there could be no unfair competition. (*Electric Auto-Lite Co. v. P. & D. Mfg. Co., Inc.*, 109 Fed. 2d 566, 567 [C. A. 2, 1940].)

The appellant cited the case of *Haeger Potteries v. Gilner Potteries*, 123 F. Supp. 261 (U. S. D. C., S. D., Cal. 1954) as one in which the California unfair competition law is discussed extensively. It is submitted that under the ruling of the mentioned case, there is no unfair competition, even if we assumed that the appellee herein deliberately copied the appellant's red frame. There must be something more than merely copying a color to spell out unfair competition.

In the *Haeger* case, *supra*, the Court found that the defendant copied not only the color but the design and shape of the ash tray, which the Court found were non-functional features. In addition, the Court, also, found that there was a confusion of source and origin of the goods. In the instant case, the packages of appellant's and the appellee's goods are not confusingly similar, and the names of the parties are prominently displayed on the face of the packages which cover the frames completely; thus, the facts

in this case are entirely different. It is interesting to note that in the *Haege* case, *supra*, the Court stated, at pp. 268, 269:

“Absent the statutory protection of a patent or a registered trademark, there is nothing to prevent an imitator from precisely copying the prior user’s product in those rare instances where the nature of the article or the circumstances of its marketing or use are held to be such as to warrant a finding that similarity to the point of duplication does not result in confusion of purchasers as to the source or origin of the product. See e.g., *Electric Auto-Lite Co. v. P. & D. Mfg. Co.*, 2 Cir., 1940, 109 F. 2d 566; *Cheney Bros. v. Doris Silk Corp.*, 2 Cir., 35 F. 2d 279, cert. den. 1929, 281 U. S. 728, 50 S. Ct. 245, 74 L. Ed. 1145; *Crescent Tool Co. v. Kilborn & Bishop Co.*, 2 Cir. 1917, 247 F. 299.”

Thus, since the ultimate consumer very rarely knows what kind of plastic battery hold down frame he is getting, the *Haege* case, *supra*, does not apply. In any event, the frames of both parties are clearly distinguished by the different cartons in which they are packed, and there can be, therefore, no unfair competition.

The appellant also permits its red frames to be sold as the product of the Western Auto Company under the trade name “Wizard”. Western Auto sells the frames in their own box, under their own name and trademark (R. pp. 258, 264, 265, 269, Ex. Q, Ex. R). Appellant also sells the red frames to another company which boxes them in their own packages (R. p. 269).

Under these circumstances, appellant, by its own acts, cannot claim distinctiveness, and assert that the red frames are theirs alone (appellant’s brief, p. 77). In any event they certainly cannot claim rights in a single primary color.

The lower Court's opinion sums up the unfair competition claim properly (R. pp. 17-19), and the findings were correct and well supported by the evidence.

CONCLUSION

The issues raised by appellant on this appeal concern questions of infringement, validity, and unfair competition. It is submitted that the law concerning the appeal is well settled, and that substantially all of the questions raised by appellant concern the lower Court's findings of fact. The evidence fully supports all the findings to an extent which makes it unnecessary to apply the "clearly erroneous" rule to the findings of the Trial Court; since it is obvious that there was no error.

There is no infringement, the claims of appellant's patent are invalid, and there is no unfair competition. The complaint was properly dismissed and the suit patent was properly declared invalid.

The decision of the Trial Court should be affirmed.

Respectfully submitted,

BUCHALTER, NEMER, FIELDS & SAVITCH,
Attorneys for Appellee.

KANE, KESSLER & PROUJANSKY,
45 John Street,
New York 38, New York,
Of Counsel for Appellee.

EDWARD HALLE,
225 Broadway,
New York 7, New York,
Of Counsel for Appellee.

